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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,006	06/24/2003	Jens Bache	4010-27	7695

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EXAMINER

JOHNSON, GREGORY L

ART UNIT	PAPER NUMBER
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3691

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/602,006	<b>Applicant(s)</b> BACHE, JENS	
	<b>Examiner</b> GREGORY JOHNSON	<b>Art Unit</b> 3691	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-8 are presented for examination

#### ***Claim Objections***

2. Claims 1, 3, 5 and 7 are objected to because of the following informalities: The claims do not provide any explanation of the meaning of the acronym CSD. For the purpose of applying prior art, the Examiner will interpret the acronym CSD to represent Central Securities Depository. Appropriate correction is required.

#### ***Double Patenting***

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-8 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4-11 of copending Application No. 10/979,809. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawkins et al. (hereinafter Hawkins), Pat. No. 6,029,146.

As to claim 1, Hawkins discloses a method for use in a CSD-system when carrying out a corporate action in the CSD-system on a security or an instrument, the method comprising the following steps:

- retrieving information about the parameters for the corporate action (col. 3, lines 48-61 and col. 7, lines 47-56),
- using said parameters, expressing the corporate action with an appropriate combination of predefined operating components (col. 3, lines 48-61 and col. 7, lines 47-56),

said components being chosen from the following group:

1. one component that generates payments to participants in the system (col. 4, lines 53-62),
2. one component that requests payment from participants in the system (col. 4, lines 53-62),

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3. one component that adds holdings to an account in the CSD-system (col. 4, lines 47-53),
  4. one component that removes instruments from circulation in the CSD-system. (col. 4, lines 47-53).
- executing the action according to the parameters and components that are included in the expressed action (col. 3, lines 61-66 and col. 7, lines 54-59).

As to claims 2 and 6, Hawkins discloses a method in which one of the parameters that are retrieved is an amount that refers to a security or instrument used in the expression for the action (col. 13, lines 31-35 and 48).

As to claims 3 and 7, Hawkins discloses a method in which one of the parameters that are retrieved is a numeral that refers to an account number in the CSD-system, a bank account or a code which identifies an individual security or instrument in the system (col. 13, lines 31-35 and 49).

As to claims 4 and 8, Hawkins discloses a method in which one of the parameters that are retrieved is a date that is a date on which the components in the expression are to be used, or when the entire expression is to be carried out (col. 14, lines 58-62).

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As to claim 5, Hawkins discloses a computerized CSD-system for carrying out corporate actions on securities or instruments, the system comprising:

- means for retrieving information about the parameters for the corporate action (col. 3, lines 48-61 and col. 7, lines 47-56),
- means for using said parameters, expressing the corporate action with an appropriate combination of predefined operating components (col. 3, lines 48-61 and col. 7, lines 47-56),

the system additionally comprising means for choosing said components from the following group:

1. one component that generates payments to participants in the system (col. 4, lines 53-62),
  2. one component that requests payment from participants in the system (col. 4, lines 53-62),
  3. one component that adds holdings to an account in the CSD-system (col. 4, lines 47-53),
  4. one component that removes instruments from circulation in the CSD-system (col. 4, lines 47-53),
- executing the action according to the parameters and components that are included in the expressed action (col. 3, lines 61-66 and col. 7, lines 54-59).

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Hawkins et al. Pat. No. 5,497,317 discloses a device and method for improving the speed and reliability of security trade settlements.
- b. Hawkins et al. Pat. No. 6,247,000 B1 discloses a method and system for confirmation and settlement for financial transactions matching.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571) 272-2025. The examiner can normally be reached on Monday - Friday, 8:00AM - 4:30PM.

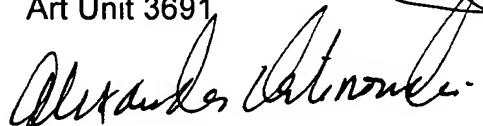
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GJ

GREGORY JOHNSON  
Examiner  
Art Unit 3691



ALEXANDER KALINOWSKI  
SUPERVISORY PATENT EXAMINER  
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